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10/670,297	09/26/2003	Ken R. Powell	104.005-04	6455

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,297

Applicant(s)

POWELL, KEN R.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Valencia et al. (US 5,380,991).

As for Claim 6, Valencia et al. discloses a computer, comprising:

(a) a processor in communication with a global computer network (see col. 4, lines 14-15, the host computer or computer system being coupled to the smart card: col. 8, lines 15-19);

(b) a smart card reader/writer circuit, in communication with the processor, capable of writing data to a smart card (see col. 4, lines 4-26; col. 6, lines 29-30 for using reader/writer); and

(c) a program that causes the processor to write data that is received via the global computer network onto a smart card via the smart card reader/writer circuit (col. 4, lines 30-36).

Claim Rejections - 35 USC § 103

3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. (US 5,710,886) in view of Valencia et al..

As for Claim 1, Christensen et al. discloses a method comprising the steps of:

(a) transmitting to the user computer, via the global computer network, data referring to the product (see Figs. 10-13);

(b) receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product (col. 8, line 42 – col. 9, line 8); and

(c) transmitting to the user computer, via the global computer network, coupon data representative of the coupon (see Id.)

However, Christensen et al. does not expressly disclose the method including the step of writing the coupon data onto the smart card with the smart card reader/writer.

Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card.

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Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the method of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, in respected to determine whether the coupons are expired and then redeemed at a central clearing house.

As for Claim 2, Christensen et al. discloses a method comprising the steps of:

(a) transmitting to the user computer, via the global computer network, data referring to the product (see Figs. 10-13);

(b) receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product (col. 8, line 42 – col. 9, line 8);

(c) transmitting to the user computer, via the global computer network, coupon data representative of the coupon (see Id.);

(e) reading the coupon data (see col. 15, line 20 – col. 16, line 26);

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(f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data (see *Id.*); and

(g) if the list of products includes data corresponding to the coupon data, then crediting the user with an amount indicated by the coupon data (see *Id.*).

However, Christensen et al. does not expressly disclose the method including the steps of writing the coupon data onto the smart card with the smart card reader/writer and reading the coupon data with the second smart card reader/writer.

Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see *Supra* Claim 1).

Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the method of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to

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avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house.

As for Claim 3, Christensen et al. discloses a method comprising the steps of:

(a) transmitting to the user computer, via the global computer network, data referring to the product (see Figs. 10-13);

(b) receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product (col. 8, line 42 – col. 9, line 8);

(c) transmitting to the user computer, via the global computer network, coupon data representative of the coupon (see Id.);

(e) reading the coupon data (see col. 15, line 20 – col. 16, line 26);

(f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data (see Id.); and

(g) if the list of products includes data corresponding to the coupon data, then reporting the coupon to a coupon clearinghouse (see Id.).

However, Christensen et al. does not expressly disclose the method including the steps of writing the coupon data onto the smart card with the smart card reader/writer and reading the coupon data with the second smart card reader/writer.

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Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see Supra Claim 1).

Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the method of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, in respected to determine whether the coupons are expired and then redeemed at a central clearing house.

As for Claim 4, Christensen et al. discloses a method comprising the steps of:

(a) transmitting to the user computer, via the global computer network, data referring to the product (see Figs. 10-13);

(b) receiving from the user computer, via the global computer network, data

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indicating that the user desires to receive a coupon for the product (col. 8, line 42 – col. 9, line 8);

(c) transmitting to the user computer, via the global computer network, coupon data representative of the coupon (see *Id.*);

(e) reading the coupon data (see col. 15, line 20 – col. 16, line 26);

(f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data (see *Id.*); and

(g) if the list of products includes data corresponding to the coupon data, then redeem the user's coupon; and reporting the coupon to a coupon clearinghouse (see *Id.*).

However, Christensen et al. does not expressly disclose the method including the steps of writing the coupon data onto the smart card with the smart card reader/writer and reading the coupon data with the second smart card reader/writer.

Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see *Supra* Claim 1).

Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

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Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the method of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house.

As for Claim 5, Christensen et al. discloses a method comprising the steps of:

- (a) viewing a plurality of available downloadable coupons received via the global computer network on the computer monitor (see Supra Figs. 10-13); and
- (b) generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons (see Fig. 14 and the description thereof)

whereby the store applies a credit specified by the coupon data to a purchase price of the product.

However, Christensen et al. does not expressly disclose the method including the steps of placing the smart card in the smart card reader/writer so that the computer

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causes data corresponding to the selected coupon to be written to the smart card; and presenting the smart card to a smart card reader/writer at the store while purchasing a product corresponding to the coupon.

Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see Supra Claim 1).

Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the method of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card and the retail store reads the smart card, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, in respected to determine whether the coupons are expired and then redeemed at a central clearing house.

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As for Claim 7, Christensen et al. discloses a system comprising:

an electronic coupon downloading apparatus (the user's computer) including: a processor in communication with a global computer network (see Fig. 2);

a checkout station, for reading the coupon data stored on the smart card held by a user, including:

(a) a cash register;

(b) a processor in communication with the cash register and with a telecommunications link (see Fig. 2);

(c) a program that executes the steps of:

(i) reading coupon data;

(ii) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data;

(iii) if the list of products includes data corresponding to the coupon data, then crediting the user with a refund of an amount indicated by the coupon data; and

(iv) reporting the coupon to a coupon clearinghouse via the telecommunications Link (see Supra Claims 3-5).

However, Christensen et al. does not expressly disclose the system including:

a first smart card reader/writer, in communication with the processor, capable of writing data to a smart card;

a second smart card reader/writer in communication with the processor.

Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the second reader/writer (see Supra Claim 1).

Since Valencia et al. and Christensen et al. are both from the same endeavor, the purpose disclosed by Valencia et al. would have been well recognized in the pertinent field of Christensen et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Christensen et al. such that the method includes a smart card and the computer system with card reader/writer in communication with the card so as to write the data into the smart card and the retail store reads the smart card with the second reader/writer, as taught by Valencia et al., for the purpose of providing a paperless coupon redemption system to avoid the traditional problem in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, in respected to determine whether the coupons are expired and then redeemed at a central clearing house.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 03-71290 is cited to show an IC card with the memory to store sensitive, private information of the user.

US 5,789,732 is cited to show a portable data device containing a memory for data and transaction retention, in which a data is in communication with a host computer.

US 5,122,643 is cited to show an IC card including a CPU and a memory and a display section for displaying the contents of the memory, and a card terminal into which the IC card can be inserted, reading the contents of the memory.

US 5,970,649 is cited to show a system and method for providing shopping aid and incentives to customer through a computer network.

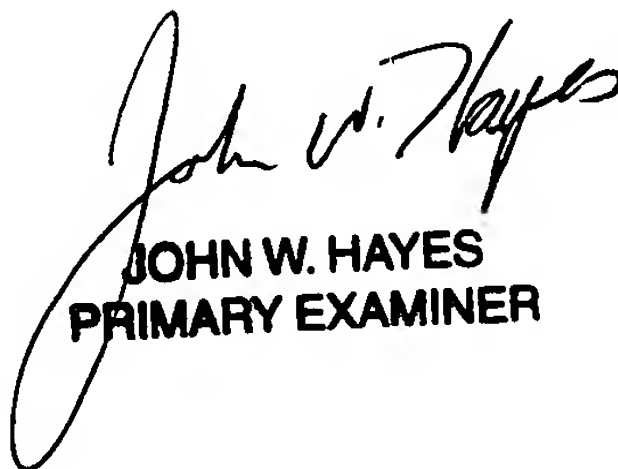
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard Woo
Patent Examiner
Art Unit 3639
June 21, 2005



JOHN W. HAYES
PRIMARY EXAMINER